

## **REMARKS/ARGUMENTS**

Claims 1, 3-8, 10-11, 13-16, 18-19 and 21-22 are pending in the present application. Claims 1, 11, 16 and 21-22 were amended. More particularly, Claims 1, 11 and 16 have respectively been amended to incorporate patentable subject matter of Claim 21. Claim 21 has been amended, to include subject matter previously included in Claim 22. Reconsideration of the claims is respectfully requested.

### **I. 35 U.S.C. § 102, Anticipation**

In the Office Action, the Examiner rejected Claims 1, 3-6, 8, 10-11, 13-16, 18-19 and 21 under 35 U.S.C. § 102 as being anticipated by U.S. Pat. Appl. Pub. No. 2004/0257346, to *Ong et al.* (hereinafter “*Ong*”). In a phone discussion between the Examiner and Applicants’ attorney on December 12, 2007, the Examiner indicated that Claim 22 was rejected on the same ground. These rejections are respectfully traversed.

### **II. 35 U.S.C. § 103, Obviousness**

The Examiner has rejected Claim 7 under 35 U.S.C. § 103, as being unpatentable over *Ong*. This rejection is respectfully traversed.

### **III. Teachings of Applicants**

In making their invention, Applicants were concerned with reducing the time and effort needed to send a document, or selected portion thereof, to another location or application. Applicants recognized that this goal could be achieved by providing a method and apparatus wherein a single user input can initiate the entire procedure of copying the selected content, and sending the content from a first application to a second application. Thus, after initiation no further user input is needed, in order to complete the transfer of content. Accordingly, with the single user input, a user is able to form copied content, and then select the second application from a plurality of different applications, over a range of application types. For example, the second application may be selected to be an email program or an instant messaging program for transmission over a network. Alternatively, the second application may be a file or word processing program located in the same data processing system as the first application. As a result, the effort required by a user to send content from one application to another is substantially reduced.

These teachings are set forth in Applicants' specification, such as at page 3, lines 3-14, and page 9, lines 23-page 10, line 13, as follows.

The present invention provides a method, apparatus, and computer instructions for sending content from a first application to a second application. In response to user input indicating a selection of content for transfer to the second application, the selection of the content is copied to form copied content. The copied content is then automatically sent to the second application without requiring additional user manipulation of the copy content. Additionally, the destination may be another user. In this case, the second application is employed to automatically transfer the copied content to that second user. **[page 3, lines 3-14]** (emphasis added)

Thereafter, the user through some selected user input, such as a right click on a mouse or other pointing device may select to send data 304 to another location. This location may be, for example, application 308 or even a file, such as file 310 within the data processing system.

Application 308 may take various forms, such as an email program, another word processing program, or an instant messaging program. In the event that application 308 is to be used as a transport mechanism to send the data to a remote location, the mechanism of the present invention may initiate the execution of application 308. Data 304 is sent to application 308 through an interface in application 308. This interface is typically an existing interface that allows for a transfer of content to the application. Alternatively, a set of scripts may be used to manipulate application 308. In these examples, the reception of the user input selecting the destination for the data and the initiation of application 308 is handled by data transfer process 312. **[page 9, line 23-page 10, line 13]**

Claim 1 now reads as follows:

1. A method in a data processing system for sending content from a first application to a second application, the method comprising the computer implemented steps of:
  - providing a plurality of different applications, wherein each of said applications is available for selection by a user as the second application that is to receive the content from the first application;
  - responsive to detecting a single user input indicating selection of a particular application of said plurality to be the second application, copying the content to form copied content; and

without further user input after said single user input, and after forming the copied content, initiating the particular selected application to be the second application, and sending the copied content to the second application.

#### IV. Rejection of Claim 1

In the Office Action, the Examiner stated the following in rejecting previous Claim 1, and also Claim 21, which is now recited as current Claim 1 with further amendment:

Per claim 1, Ong discloses a system and method for sending content from a first application to a second application comprising:

- a) responsive to detecting a user input indicating a selection of the content, copying the selection of the content to form captured/copied content (see par. 56);
- b) presenting a graphical user interface and automatically capturing/copying the selection of the content in response to user's selection of a transfer type through the graphical user interface (see par. 57-58);
- c) automatically sending the copied content to the second application (see par. 62) wherein sending the copied content further comprises initiating the second application, e.g., opening editor (see par. 29) or use email client (see par. 143).

Per claim 21, Ong teaches initiating a second application automatically without further user input upon receiving a function selected by a user (see par. 57-58).

Principal teachings of *Ong* are set forth at paragraphs [0048] – [0049], [0056] – [0058] and [0143] – [0144]. These are as follows:

**[0048] FIG. 2** illustrates an illustrative tablet PC **201** that can be used in accordance with various aspects of the present invention. Any or all of the features, subsystems, and functions in the system of **FIG. 1** can be included in the computer of **FIG. 2**. Tablet PC **201** includes a large display surface **202**, e.g., a digitizing flat panel display, preferably, a liquid crystal display (LCD) screen, on which a plurality of windows **203** is displayed. Using stylus **204**, a user can select, highlight, and/or write on the digitizing display surface **202**. Examples of suitable digitizing display surfaces **202** include electromagnetic pen digitizers, such as Mutoh or Wacom pen digitizers. Other types of pen digitizers, e.g., optical digitizers, may also be used. Tablet PC **201** interprets gestures made using stylus **204** in order to manipulate data, enter text, create drawings, and/or execute conventional computer application tasks such as spreadsheets, word processing programs, and the like.

**[0049]** The stylus **204** may be equipped with one or more buttons or other features to augment its selection capabilities. In one embodiment, the stylus **204** could be implemented as a "pencil" or "pen", in which one end constitutes a writing portion and the other end constitutes an "eraser" end, and which, when moved across the display, indicates portions of the display are to be erased. Other types of input devices, such as a mouse, trackball, or the like could be used. Additionally, a user's own finger could be the stylus **204** and used for selecting or indicating portions of the displayed image on a touch-sensitive or proximity-sensitive display. Consequently, the term "user input device", as used herein, is intended to have a broad definition and encompasses many variations on well-known input devices such as stylus **204**. Region **205** shows a feedback region or contact region permitting the user to determine where the stylus **204** as contacted the display surface **202**.

**[0056] FIG. 4** shows the designation of content in accordance with aspect of the present invention. Content is displayed in region **401**. A user wants to capture content in the vicinity of content **402**. A user may use stylus **403** to encircle content **402** by using stylus

**403.** To provide the user with an indication of the content as being selected, the system may display the track of stylus **403** as path **404**. Path **404** may be displayed as thick or thin, opaque ink. Alternatively, path **404** may be displayed as translucent ink so as to permit a user to see the content **402** beneath the ink. Further, path **404** may not be displayed as a boundary, but rather may separate various levels of shading to distinguish selected region **402** from on selected regions. The system may determine the selection of region **402** based on the completion of a closed shape made by the stylus **403**. Alternatively, the system may determine the selection based on content partially encircled by the stylus **403** and drawing a connecting line between the stylus' current position and the position where the stylus was first placed on the screen.

[0057] **FIG. 5** shows a number of tools available on a toolbar **501**. Toolbar **501** may appear after ink path **404** is complete. Alternatively, toolbar **501** may appear after stylus **403** has been lifted off the display. Further, toolbar **501** may appear based on a gesture or click of a button on stylus **403**.

[0058] Toolbar **501** includes a number of options that may be used with designated content **402**. For instance, a user may copy designated content **402** to a clipboard upon selection of a first button **502**. A user may save the content of region **402** by selection of button **503**. A user may e-mail the content of region **402** upon selection of button **504**. The email feature permits users to easily share information by emailing the captured image and any annotation, or by copying it to a clipboard so that it can be pasted into another program.

[0143] Various applications may be used additionally to handle captured content. For instance one may email or print the designated content, among other options. Also, one may have content (from any source) and push it into the editor to add annotations.

[0144] As to emailing the content, the content may be sent through a mail client or may be sent through a mail client embedded within another application (for instance, in a word processing application).

## **V. Claim 1 Distinguishes over Cited Reference**

A prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. *In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990). All limitations of the claimed invention must be considered when determining patentability. *In re Lowry*, 32 F.3d 1579, 1582, 32 U.S.P.Q.2d 1031, 1034 (Fed. Cir. 1994). Anticipation focuses on whether a claim reads on the product or process a prior art reference discloses, not on what the reference broadly teaches. *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 218 U.S.P.Q. 781 (Fed Cir. 1983). Moreover, it is a fundamental principle of patent law that prior art must be considered in its entirety. **MPEP 2141.02.**

Applicants respectfully submit that the cited *Og* reference fails to teach every element of the claimed invention, arranged as they are in new Claim 21. For example, *Ong* does not teach, in the overall combination of Claim 1, the following combination feature:

Responsive to detecting a single user input indicating selection of a particular application of the plurality to be the second application, copying the content to form copied content, and without further user input after the single user input, and after forming the copied content, initiating the particular selected application to be the second application, and sending the copied content to the second application (hereinafter “Single User Input” feature).

*Ong* is directed to an arrangement wherein a user manipulates a stylus on a surface, such as the display surface 202 of Figure 2, in order to select or designate displayed data content for copying or other use. As taught at paragraphs [0048] and [0049] of *Ong*, the stylus could be implemented as a “pen” or “pencil”. The stylus could alternatively comprise a range of other user input devices, such as a mouse, trackball or the user’s finger. As an example, paragraph [0056] and Figure 4 of *Ong* disclose use of a stylus 403 to acquire content 402 by encircling it on a display region 401.

The Single User Input feature of Claim 1 teaches that in response to a single user input indicating the selection of a particular application to be the second application, several events occur. Claim 1 recites these events to be (1) copying the content to form copied content; (2) after forming the copied content, initiating the particular application to be the second application; and (3) sending the copied content to the second application. Moreover, the recitation of Claim 1 emphasizes that these events occur without any further user input, after the single user input.

In the Office Action, the only section of *Ong* cited in connection with this feature of Claim 1, which was recited previously in Claim 21, is paragraphs [0057] – [0058] of *Ong*, cited of the Office Action on page 3 in regard to Applicants’ Claim 21. These paragraphs, together with paragraph [0056], clearly teach that content is first captured or copied. Then, as taught at paragraph [0058], a user operates one of a number of buttons on a toolbar 501, in order to take further action. For example, by operating a button 504, the user can e-mail the previously captured or copied content. Thus, the clear and fair teaching of *Ong* is a process that requires multiple user inputs, in order to copy and then send content using multiple user inputs, rather than the single user input as claimed in Claim 1.

Moreover, the different teaching of *Ong* is reinforced such as at paragraph [0066] and Figures 7 and 8. Therein, *Ong* discloses use of multiple taps of a stylus by a user, together with use of the toolbar 501, in order to process designated content. In stressing the need for such multiple user inputs, *Ong* is considered to clearly not teach the Single User Input feature, as recited by Applicants’ Claim 1.

**VI. Remaining Claims Distinguish Over Cited Reference**

Independent Claims 11, 16 and 21 respectively incorporate subject matter similar to the patentable subject matter of Claim 1, and are each considered to distinguish over the art for the same reasons given in support thereof.

Claims 3-8 and 10 respectively depend from Claim 1, and are each considered to patentably distinguish over the art for at least the same reasons given in support thereof.

Claims 13-15 respectively depend from Claim 11, and are each considered to patentably distinguish over the art for at least the same reasons given in support thereof.

Claims 18-19 respectively depend from Claim 16, and are each considered to patentably distinguish over the art for at least the same reasons given in support thereof.

Claim 22 depends from Claim 21, and is considered to patentably distinguish over the art for at least the same reasons given in support thereof.

**VII. Conclusion**

It is respectfully urged that the subject application is patentable over *Ong* and is now in condition for allowance.

The Examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the Examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

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Respectfully submitted,

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